



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re :

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 8, 11, 12, 15, 24 and 48 of the morning section and questions 11, 13 and 26 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 66. On August 9, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional two (2) points for morning questions 11 and 12. Accordingly, petitioner has been granted an additional two (2) points on the Examination. No credit has been awarded for morning questions 8, 15, 24 and 48 and afternoon questions 11, 13 and 26. Petitioner's arguments for these questions are addressed individually below.

Morning question 8 reads as follows:

8. On March 20, 2000, Patsy Practitioner filed a patent application on widget Y for the ABC Company based on a patent application filed in Germany for which benefit of priority was claimed. The sole inventor of widget Y is Clark. On September 13, 2000, Patsy received a first Office action on the merits rejecting all the claims of widget Y under 35 U.S.C. § 103(a) as being obvious over Jones in view of Smith. When reviewing the Jones reference, Patsy notices that the assignee is the ABC Company, that the Jones patent application was filed on April 3, 1999, and that the Jones patent was granted on January 24, 2000. Jones does not claim the same patentable invention as Clark's patent application on widget Y. Patsy wants to overcome the rejection without amending the claims. Which of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?

(A) A reply traversing the rejection by correctly arguing that Jones in view of Smith fails to teach widget Y as claimed, and specifically and correctly pointing out claimed elements that the combination lacks.

(B) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.131 that antedates the Jones reference.

(C) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results.

(D) A reply traversing the rejection by stating that the invention of widget Y and the Jones patent were commonly owned by ABC Company at the time of the invention of widget Y, and therefore, Jones is disqualified as a reference via 35 U.S.C. § 103(c).

(E) A reply traversing the rejection by perfecting a claim of priority to Clark's German application, filed March 21, 1999, disclosing widget Y under 35 U.S.C. § 119(a)-(d).

8. The model answer: The correct answer is (D). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g). In this situation, the Jones patent qualifies as prior art under § 102(a) because it was issued prior to the filing of the Clark application. See MPEP § 706.02(l)(3). ~~Also, evidence of common ownership must be, but has not been, presented. Mere argument or a statement alleging common ownership does not suffice to establish common ownership.~~ Answer (A) is a proper reply in that it addresses the examiner's rejection by specifically pointing out why the examiner failed to make a prima facie showing of obviousness. See 37 C.F.R. § 1.111. Answer (B) is a proper reply. See MPEP § 715. Answer (C) is a proper reply. See MPEP § 716. Answer (E) is a proper reply because perfecting a claim of priority to an earlier filed German application disqualifies the Jones reference as prior art.

Petitioner argues that answer (B) is the most correct response. Petitioner contends that the fact pattern fails to provide the subsections under 102 for the 103 rejection.

Petitioner argues that since it the reference might have been relied upon under 102(e), then (D) would have been true and an incorrect answer. Petitioner argues that answer (B) would not remove a 102(e) rejection, or a 102(a) rejection because the filing date of Jones is before the filing date of Clark's patent application.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that an affidavit or declaration under 37 CFR 1.131 would not antedate the Jones reference, because the filing date of Jones is before the filing date of Clark's patent application. An affidavit or declaration under 37 CFR 1.131 could be used to swear back behind a reference under 102(a) and (e). See MPEP 715. The Jones patent was granted on January 24, 2000, and was filed on April 3, 1999. Since, Y's application was filed on March 20, 2000, the reference qualifies as prior art under 102(a) and (e) because the Jones patent issued before and was filed before Y's application was filed. Since the reference also qualifies as prior art under 102(a), the 103(c) exclusion does not apply. Therefore, selection (B) is in accord and an incorrect response. Accordingly, model answer (D) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 15 reads as follows:

15. Able is a registered solo practitioner. Ben asks Able to prepare and prosecute an application for a utility patent. As part of the application, Able prepares a declaration and power of attorney, which Ben reviews and signs. Able files the application, the declaration, and power of attorney with the USPTO. Able quickly recognizes that help is necessary and contacts another registered practitioner, Chris, who often assists Able in such instances. Able, with Ben's consent, sends a proper associate power of attorney to the Office for Ben's application and directs that correspondence be sent to Chris. The examiner in the application takes up the application in the regular course of examination and sends out a rejection in an Office action. Chris sends a copy of the action to Ben to obtain Ben's comments on a proposed response. Unfortunately, after the first Office action, Able becomes terminally ill and dies. Ben does not know what to do, so Ben calls the examiner at the number on the Office action and explains that A died and Ben is worried how to proceed. Which of the following statement(s) is/are true?

(A) Chris should inform Ben that the Office will not correspond with both the registered representative and the applicant and therefore, Ben should not have any further contact with the Office and let Chris send in a proper response.

(B) Ben should send in a new power of attorney for anyone Ben intends to represent him before the Office.

(C) Ben should execute and sent to the USPTO a new power of attorney for any registered patent practitioner that Ben intends to have represent him before the Office.

(D) (B) and (C).

(E) None of the above.

15. The model answer: (C). MPEP § 406. Answer (C) is a true statement because the Ben may appoint a registered practitioner to represent him. Answer (A) is incorrect because the power of a principal attorney will be revoked or terminated by his or her death. Such a revocation or termination of the power of the principal attorney will also terminate the power of those appointed by the principal attorney. Therefore, Chris's associate power of attorney is revoked and Chris cannot continue representing Ben without a new power of attorney from Ben. Furthermore, the Office will send correspondence to both Chris and Ben in the event of notification of Able's death. (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application and because it does not require the power of attorney to be executed (*cf.* answer (C)). (D) is not the best answer because it includes (B). (E) is false because (C) is true.

Petitioner argues that answer (D) is also correct. Petitioner contends that both answers (B) and (C) are correct since the PTO has previously not explicitly stated that the practitioners are registered in ten other questions on the exam. Thus, it would be improper in this question for the PTO to expect the test taker in this question not to presume the practitioner is a registered practitioner. Presuming the practitioner is a registered practitioner, then B would also be true and answer (D) would be a correct answer. Petitioner also argues that since the applicant retained a registered practitioner in the first instance that he understands the importance of obtaining a registered practitioner and would thus obtain another registered practitioner. Petitioner further states that (A) could be true.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the PTO expects the test take to presume the practitioner is this question is a registered practitioner, choice B states that "Ben should send in a new power of attorney for anyone Ben intends to represent him before the Office", not a "practitioner" as argued by petitioner. Selection (B) indicates that Ben may send in a power of attorney for anyone, as distinguished from selection (C) that indicates that Ben may send in a power of attorney for only a registered practitioner. Since "anyone" could include someone that is a non-registered practitioner, and is not limited to a registered practitioner, petitioner cannot make the assumption that Ben would appoint a registered practitioner. Since, directions for the examination state, "Do not assume any additional facts not presented in the questions", petitioner may assume that Ben would appoint a registered practitioner, because he appointed a registered practitioner the first time. Accordingly, answer (D) is not correct because answer (B) is not correct and answer (C) is the most correct choice.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 24 reads as follows:

24. Mr. Brick, the inventor, files an application with the USPTO on January 2, 2001 containing a single claim for his invention: a new bouncing ball called "Y". Brick receives a first Office action dated June 4, 2001 from the primary examiner handling Brick's application. The examiner rejected Brick's claim only under 35 U.S.C. § 103 on the grounds that Reference X teaches a bouncing ball called "Q," and that although "Y" and "Q" are not the same, it would have been obvious to one of ordinary skill to make changes to the "Q" ball in order to obtain a ball just like Brick's "Y" ball. On August 2, 2001, Brick responds by stating that his new "Y" ball bounces unexpectedly higher than the "Q" ball described in Reference X. Brick includes a declaration, signed by Mrs. Kane, that includes extensive data comparing the bouncing results for the "Y" and "Q" balls and showing that the "Y" ball bounces unexpectedly higher than the "Q" ball. Brick argues that the rejection under 35 U.S.C. § 103 should be withdrawn because he has proven that, in view of the unexpectedly higher bounce of the "Y" ball as compared to the "Q" ball, it would not have been obvious to one of ordinary skill in the art to make changes to the "Q" ball to obtain Brick's "Y" ball. On October 2, 2001, Brick receives a final rejection from the examiner. The rejection states, in its entirety: "The response has been reviewed but has not been found persuasive as to error in the rejection. The claim is finally rejected under 35 U.S.C. § 103 for the reasons given in the first Office action." Brick believes he is entitled to a patent to his new bouncing ball "Y." How should Brick proceed?

(A) Brick should give up because the declaration did not persuade the examiner of the merits of Brick's invention.

(B) Brick should timely file a Request for Reconsideration asking the examiner to reconsider the rejection on the basis of the Kane declaration and, as a precaution against the Request for Reconsideration being unsuccessful, also timely file a Notice of Appeal.

(C) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide an enabling disclosure for a new ball with the unexpectedly higher bounce of his "Y" ball.

(D) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide a written description for a new ball with the unexpectedly higher bounce of his "Y" ball.

(E) Brick should respond by submitting a request for reconsideration presenting an argument the declaration data proves that the "Q" ball and the "Y" are not identical.

24. The model answer: (B) is the correct answer. It is inappropriate and injudicious to disregard any admissible evidence in any judicial proceeding. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). The examiner has not analyzed the data in the declaration nor provided an explanation as to why the declaration did not overcome the rejection. Furthermore, the rejection has not been reviewed anew in light of the declaration. The examiner should have reweighed the entire merits of the *prima facie* case of obviousness in light of the data. *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986). Accordingly, Brick should ask that the rejection be reconsidered and file a Notice of Appeal to safeguard his interest for a review of the rejection by the Board of Patent Appeals and Interferences if the rejection is not reconsidered. 37 C.F.R. § 1.116. (A) is wrong because there is no evidence that the examiner made any review of the declaration. (C) is wrong because whether or not Reference X provides an enabling disclosure for Brick's invention is immaterial to the question of obviousness. If there were to be a question of enabling disclosure for Reference X, it would be with respect to the "Q" ball relied upon by the examiner, not applicant's "Y" ball. (D) is wrong because whether or not Reference X provides a written description for Brick's invention is immaterial to the question of obviousness raised by the examiner. (E) is wrong because the issue is one of obviousness under 35 U.S.C. § 103, not identity under 35 U.S.C. § 102. Given that the examiner has rejected the claim under 35 U.S.C. § 103 and not under § 102, the examiner has already conceded that the "Q" and "Y" balls are not the same.

Petitioner argues that answer (C) is correct. Petitioner contends that the possible answer falls into two categories, either giving up or submitting a request for reconsideration that submits an argument. Petitioner argues that more information is needed and that while giving up may not be in Bricks best interest, it may be the most practical choice in view of cost or market timing. Petitioner further argues that requesting reconsideration is probably a worse choice because there is little reason to believe the examiner will change his mind, since the examiner has already stated that the previous response had been reviewed, thus it would just be a waste of time and money to request reconsideration. Petitioner contends that without more information, none of the responses are appropriate to the final rejection.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that Brick should give up or request reconsideration with arguments that the reference X does not provide an enabling disclosure for a new ball with the unexpectedly higher bounce of his "Y" ball, Brick should ask that the rejection be reconsidered and file a Notice of Appeal to safeguard his interest for a review of the rejection by the Board of Patent Appeals and Interferences if the rejection is not reconsidered. It is inappropriate for the examiner to disregard properly presented evidence and not present reasons why it is not persuasive. The instructions state "[d]o not assume any additional facts not presented in the questions", petitioner's answer presumes that the examiner will not change his mind and that there might be a problem with cost or market timing. The question is "[h]ow should Brick proceed". Accordingly, model answer (B) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 48 reads as follows:

48. Engineers and scientists at Poly Tech Institute (PTI) have invented a new system for a wireless computer network. On November 9, 2001, they asked you to file a U.S. patent application for their invention. PTI is located in the United States, has an attendance of over 5,000 students, and (1) admits, as regular students, only persons having a certificate of graduation from a school providing secondary education, or the recognized equivalent of such a certificate, (2) is legally authorized within the jurisdiction in which it operates to provide a program of education beyond secondary education, (3) provides an educational program for which it awards a bachelor's degree or provides less than a 2-year program which is acceptable for full credit toward such a degree, (4) is a public institution, and (5) is accredited by a nationally recognized accrediting agency. You also find out that Poly Tech's research which led to the invention of the new system was funded by Atlantic Telcom Corporation (ATC) (a for profit corporation with over 500 employees and that does not meet the small business standard defined in 13 CFR 121) and a license agreement has been signed which would give ATC the right to participate in the prosecution of the patent application and also the right to make and use the invention, upon the payment of royalties, if the application ultimately issues as a patent. Based on the above facts, you should advise PTI that:

- (A) the application must be filed under large entity status because enrollment in the university exceeds 500.
- (B) the application must be filed under large entity status because PTI has entered into a license agreement.
- (C) the application may be filed under small entity status because the enrollment at PTI exceeds 5000 students.
- (D) the application may be filed under small entity status because PTI is an institution of higher education located in the United States.
- (E) None of the above.

48. The model answer: (B) is the most correct answer. 37 C.F.R. § 1.27 (a)(3)(i) & (ii) which prohibits claiming of small entity status if the nonprofit organization (a university) has assigned, granted, conveyed, or licensed any rights in the invention to any person, concern, or organization which would not qualify as a person, small business concern, or

a nonprofit organization. In the example above, the licensee, ATC, does not qualify for small entity status. See also MPEP § 509.02 at pp. 500-32 to 500-34. Answer (A) is incorrect, because it does not matter that the university has over 500 students. A university can still qualify for small entity status even though it has more than 500 students. 37 C.F.R. § 1.27(a)(3)(ii)(A). Answer (C) is incorrect because the invention has been licensed to a large entity, and the size of the student body does not determine whether a university qualifies as a small entity. Answer (D) is incorrect because although PTI is an institution of higher education, there has been a license to an organization that does not qualify for small entity status. Answer (E) is incorrect because answer (B) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that the model answer can reasonably be untrue because the answer states that the application must be filed as a large entity because the company had entered into a license agreement. Petitioner contends that this means that PTI would have to file as a large entity for entering into any license agreement, even one with a small entity. Petitioner contends that (B) would be correct if it stated “the license agreement with Atlantic Telecom Corporation”. Petitioner argues that (B) is at least indefinite, thus incorrect and that the best answer is (E).

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that answer (B) is indefinite and an incorrect response, because it refers to any license agreement. The instructions state “[d]o not assume any additional facts not presented in the questions”, petitioner’s answer presumes that there is another license agreement. The question is “[b]ased on the above facts, you should advise PTI that” it must file as a large entity, because it signed the license agreement. There is only one license agreement in the fact pattern and it is the one that PTI signed with the large entity ACT, which causes it to have to file as a large entity. Accordingly, model answer (B) is correct and petitioner’s answer (E) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 11 reads as follows:

11. While vacationing in Mexico on April 14, 2001, Henrietta invented a camera that operated at high temperature and is waterproof. She carefully documented her invention and filed a provisional application in the USPTO on April 30, 2001. She conducted tests in which the camera withstood temperatures of up to 350 degrees Fahrenheit. However, when the camera was placed in the water leaks were discovered rendering the camera inoperable. On April 12, 2002, Henrietta conceived of means that she rightfully believed will fix the leakage issue. Henrietta came to you and asked whether she can file another application. Henrietta desires to obtain the broadest patent protection available to her.

Which of the following is the best manner in accordance with proper USPTO practice and procedure for obtaining the patent covering both aspects of her invention?

(A) She can file a nonprovisional application on April 30, 2002 claiming benefit of the filing date of the provisional application, disclosing the means for fixing the leak and presenting a claim covering a camera that operates at high temperatures and a claim covering a camera that is waterproof, or presenting a claim covering a camera that both operates at high temperatures and is waterproof.

(B) Henrietta cannot rightfully claim a camera that is waterproof in a nonprovisional application filed on April 30, 2002, since she tested the camera and the camera developed leaks.

(C) Henrietta can file another provisional application on April 30, 2002 and obtain benefit of the filing of the provisional application filed on April 30, 2001.

(D) Henrietta may establish a date of April 14, 2001 for a reduction to practice of her invention for claims directed to the waterproofing feature.

(E) Henrietta should file a nonprovisional application on April 30, 2002 having claims directed only to a camera that withstands high temperatures since the camera that she tested developed leaks.

11. The model answer: (A). As to (B) and (E), an actual reduction to practice is not a necessary requirement for filing an application so long as the specification enables one of ordinary skill in the art to make and use the invention. However, (D) is incorrect, as a reduction to practice may not be established since the camera leaked. As to (C), a second provisional is not entitled to the benefit of the filing date of the first provisional application. 35 U.S.C. § 111(b)(7).

Petitioner argues that answer (E) is correct. Petitioner contends that the applicant cannot properly claim priority to subject matter that was inoperable in the original application for lack of utility as to the waterproof aspects, making (A) incorrect. Petitioner also argues that claiming benefit to the earlier application as suggested in selection (A) is contrary to proper PTO practice because that camera resulted in leaking.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the applicant cannot claim priority to claimed subject matter that was inoperable in the original application for lack of utility as to the waterproof aspects, making (A) incorrect, and (E) is the only remaining correct selection, a nonprovisional application may claim the benefit of the filing date of an earlier-filed provisional application for the subject matter disclosed in the provisional application. Henrietta's provisional application provides support for a camera that can operate at high temperature. Furthermore, answer (A) is correct because Henrietta would obtain the broadest patent protection, covering both aspects of her invention, a camera that operated

at high temperature and is waterproof. Answer (E) is incorrect because Henrietta would not obtain patent protection for the means that fix the leakage issue. Accordingly, model answer (A) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 13 reads as follows:

13. Which of the following is or are a factor that will be considered in disapproving a preliminary amendment in an application filed November 10, 2000?

(A) The nature of any changes to the claims or specification that would result from entry of the preliminary amendment.

(B) The state of preparation of a first Office action as of the date of receipt of the preliminary amendment by the Office.

(C) The state of preparation of a first Office action as of the certificate of mailing date under 37 CFR 1.8, of the preliminary amendment.

(D) All of the above.

(E) (A) and (B).

13. The model answer: (E) is the correct answer. 37 C.F.R. § 1.115(b)(1). As stated in 65 FR at 54636, middle and right columns, "Factors that will be considered in disapproving a preliminary amendment include: the state of preparation of a first Office action as of the date of receipt (§1.6, which does not include § 1.8 certificate of mailing dates) of the preliminary amendment by the Office..." Thus, choices (C) and (D) are incorrect.

Petitioner argues that answer (D) is correct. Petitioner contends that due to the mail delays caused by the events of September 11, 2001, a certificate of mailing would also be taken into account by the USPTO as a factor in considering a preliminary amendment in an application filed November 10, 2000, and cites 37 CFR 1.183, regarding suspension of the rules. Petitioner argues that while the application was filed on November 10, 2000, that doesn't mean the USPTO would have reacted differently if such events had happened around November 10, 2000.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the state of preparation of a first Office action as of the certificate of mailing date would be considered in disapproving a preliminary amendment in an application filed November 10, 2000, it is not considered. See 37 CFR 1.115(b)(1). "Factors that will be considered in disapproving a preliminary amendment

include: the state of preparation of a first Office action as of the date of receipt (§1.6, which does not include § 1.8 certificate of mailing dates) of the preliminary amendment by the Office...". Petitioner's arguments on what might have happened are not persuasive, as the directions for the examination state, "Do not assume any additional facts not presented in the questions." Accordingly, model answer E is correct and petitioner's answer D is incorrect.

Afternoon question 26 reads as follows:

26. Jack Flash filed an application for patent on December 16, 1998, disclosing and claiming self-extinguishing safety candles, methods of making them, and a special reflective housing for holding the burning candles. Following a three-way restriction, Mr. Flash prosecuted the claims for the candle, and was granted a patent ("P1"), which issued on April 6, 1999. Mr. Flash filed a divisional application containing claims for the method of making the candles and for the reflective housing on April 5, 1999. The examiner did not restrict the claims, but before the first action on the merits was mailed, Mr. Flash suffered business reversals and canceled the claims to the reflective housing to reduce the cost of obtaining his patent. A patent on the method of making the candles ("P2"), issued on November 30, 1999. Although you reviewed and signed all of the papers in the prosecution of the applications, your assistant, Annie, did all the work under your supervision. On April 1, 2001, Mr. Flash jumps into your office. He has just won a million dollars on some television game show you've never heard of, and he wants to "revive his patents." He is also concerned about an article he tore out of the February 1986 issue of the trade publication Wicks and Sticks, that shows a drawing of a dissimilar candle that would nevertheless raise a question of patentability, with the caption "It's just a dream: it can't be made we've tried a thousand times, don't bother." He also has a video tape first sold by a local hobbyist at his store in October 1999, showing a process of candle making that may be within the scope of his process claims. "But it's such a stupid way to do things - it's expensive and it doesn't work very well- it doesn't even make a safety candle," Jack shouts, jumping on your desk. He is so excited he can barely get the words out. Annie volunteers to work with him to figure out what he can do. On the next day, Friday, April 2, just as you are getting ready to close up and head for the LeTort Creek with your cane rod Annie drops five proposals on your desk. After reviewing Annie's proposals, but before you leave, you must instruct her to take the action that will best protect Mr. Flash's patent rights. Which of the following acts would be in accordance with proper USPTO practice and procedure, and Annie should be authorized to follow?

(A) File a broadening reissue application on P1, alleging error in failing to claim sufficiently broadly by not filing claims for the reflective housing.

(B) File a request for reexamination of P1 based on the Wicks and Sticks article.

(C) File a new, nonprovisional patent application claiming benefit of the filing date of parent application that issued as patent P2.

(D) File a request for reexamination of P2 in view of the video tape, intending to narrow the process claims to avoid the video tape if the USPTO finds a significant new question of patentability, and seeking to add claims to the reflective housing.

(E) File a broadening reissue of P2, alleging error in claiming the process too broadly, because it covers the process disclosed on the video tape, and alleging further error in claiming less than the inventor had a right to claim, by not claiming the reflective housing.

26. The model answer: The best answer is (B), because, under the facts as stated, the Wicks and Sticks article "shows a drawing of a dissimilar candle that would nevertheless *raise a question of patentability*" (italics added). Although the published article might not be anticipatory, it can raise a substantial new question of patentability under 37 C.F.R. § 1.515. (A) is incorrect because it is not error to fail to claim restricted inventions that were not elected and that were not claimed in divisional applications. In re *Orita* 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977); MPEP § 1450. (C) is not the best answer because there is no copendency between the new nonprovisional application and parent application that issued as patent P2. 35 U.S.C. § 120. (D) is not correct because a request for reexamination cannot be based on a video tape ~~broadened claims may not be filed in a reexamination~~. (E) is not the best answer because it is not clear there is an "error" under 35 U.S.C. § 251 with respect to the claims for the reflective housing. MPEP §§ 1402, 1450.

Petitioner argues that answer (E) is correct. Petitioner contends that the model answer is not the best answer because a reexamination requires a reference to be either new or substantial, and the Wicks and Sticks reference would not affect Flash's patent based on obviousness. Petitioner contends that filing a request for reexamination would "accomplish nothing except waste a lot of money and strengthen the patent. It may even trigger a lawsuit". Petitioner contends that it was an error for patentee to claim less than he had a right to claim. Petitioner contends that it was a practical error to cancel the claims and such an error could be due to a lapse in communication between the practitioner and Flash. Petitioner further contends that the claims for the housing were voluntarily canceled before the first Office action was mailed, thus the claims were not surrendered to obtain a patent. Petitioner contends that the broadening reissue could be filed on P2, as it is within two years of patent issue and it will increase Flash's patent rights.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that a request for reexamination would accomplish nothing but waste a lot of money, the article including the drawing raises a new question of patentability, that would probably be overcome due to the negative comments, which would strengthen the patent. Selection (E) is wrong because filing a reissue alleging an

error in claiming the process too broadly because it covers the process disclosed on the video tape would also cause the scope of the claims to need to be narrowed, when it might not be necessary to narrow the scope of the claims. With respect to adding additional claims to claim the reflective housing, failing to timely file a divisional application is not correctable by reissue. Applicant's first application was subject to a restriction requirement and applicant failed to file two divisional applications. Furthermore, while petitioner argues that the canceling of the claims may have been caused by a lapse in communication between the practitioner and Flash, the facts clearly state Flash canceled the claims to the reflective housing to reduce the cost of obtaining his patent, because of business reversals. Accordingly, model answer (B) is correct and petitioner's answer (E) is incorrect.


No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, two (2) points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above the printed name and title.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy